

Attorney Docket No.: **BMS-0010**
Inventors: **Weinmann et al.**
Serial No.: **09/687,609**
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Group I, claims 1-14, 18 and 19, drawn to a crystal of an AR-LBD, classified in Class 530, subclass 538;

Group II, claims 15-17, drawn to a machine-readable storage medium, classified in Class 703, subclass 1;

Group III, claim 20, drawn to a method for obtaining structural information about a molecule or a molecule complex of unknown structure, classified in Class 702, subclass 27;

Group IV, class 21, drawn to a computational method for designing an androgen receptor synthetic ligand, classified in Class 703, subclass 11;

Group V, claims 22-28, drawn to a method for identifying a compound that modulates androgen receptor activity, classified in Class 703, subclass 2;

Group VI, claim 29, drawn to an AR modulator, classified in Class 552, subclass 540;

Group VII, claim 30, drawn to a method for treating prostate cancer by administering an effective amount of an AR modulator, classified in Class 514, subclass 178; and

Group VIII, claims 31 and 32, drawn to a method for treating age related disease (as an osteoporosis, muscle wasting or loss of libido) by administering an effective amount of an AR modulator; classified in Class 514, subclass 178.

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The Examiner suggests that these Groups are patentably distinct from each other.

Specifically, with respect to Group I or VI and Group II, the Examiner suggests that they have different functions and effects.

With respect to Groups I and III, IV, V, VII, or VIII, the Examiner has acknowledged their relatedness as product and process of use, but suggests that the product can be used in alternative methods.

With respect to Groups I and VI, the Examiner suggests that they are physically, chemically and functionally distinct products and can have different uses.

With respect to Group II and Groups III, IV, V, VII, or VIII, the Examiner suggests that the machine-readable data storage medium of Group II is not required for the methods of Groups III, IV, V, VII, or VIII.

With respect to Groups III, IV, V, VII and VIII, the Examiner suggests that they are distinct methods because of different functions, different effects and different modes of operation.

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Further, the Examiner suggests that each Group would require a distinct and different search with minimal overlap and thus would be an undue burden.

Applicants respectfully traverse this Restriction Requirement.

MPEP §803 provides two criteria which must be met for a restriction requirement to be proper. The first is that the inventions be independent or distinct. The second is that there would be a serious burden on the Examiner if the restriction is not required. A proper search of the prior art relating to the AR-LBD crystal structure of Group I should also reveal any prior art relating to the methods for use as set forth in Groups II, III, IV, V, VII, and VIII, modulators identified via the crystal structure as set forth in Group VI and means for storing the crystal coordinates as set forth in Group II. Thus, it does not appear that a serious burden would be placed upon the Examiner if restriction were not made.

Accordingly, since this Restriction Requirement does not meet both criteria as set forth in MPEP § 803 to be proper, it is respectfully requested that this Restriction Requirement be withdrawn.

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However, in an earnest effort to be completely responsive, Applicants elect Group I, claims 1-14, 18 and 19 with traverse.

The Examiner has further subjected Group I to a species election as follows:

Species 1A: no ligand; and

Species 1B: with ligand, with a further species election to

Species IAA: whole enzyme AR-LBD;

Species IBB: binding site only; or

Species ICC: part of ligand binding site.

The Examiner suggests that the species are distinct because they each add a feature to a crystal of an AR-LBD and for binding sites or ligand with different structures and distinct features which would require separate and burdensome searches.

Applicants respectfully traverse this requirement for species election.

In accordance with MPEP § 808.01, an election of species should be made when a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required. In the instant case, the claims are not drawn to such a large multiplicity that search of all species would be unduly extensive or burdensome. Only 2 species are actually recited in generic claim 1 and only 5 total species have been set forth by

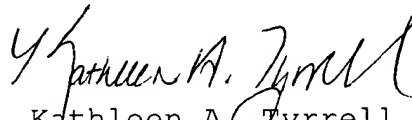
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the Examiner, all of which are inclusive of part of the AR-LBD. Clearly any search of the prior art relating AR-LBD would also reveal references teaching the AR-LBD with and without a ligand, as well as references disclosing the binding site or a part of the ligand binding site. Thus, contrary to the Examiner's suggestion, separate searches should not be required. Accordingly, reconsideration of this species election requirement is respectfully requested.

However, in an earnest effort to advance the prosecution of this case, Applicants elect the whole enzyme AR-LBD, with ligand, with traverse.

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

Respectfully submitted,


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